

Remarks

I. Status of the Claims

Applicants thank Examiner Pak for entering the claim amendments proposed in Applicants' Amendment and Reply filed on September 9, 2003. Claims 1-9, 11-28, 37, 40 and 41¹ are pending in the application, with claims 1, 37 and 41 being the independent claims and with claims 11-16 having been withdrawn from consideration by the Examiner.

II. Summary of the Advisory Action

In the Advisory Action dated November 17, 2003, the Examiner has maintained the withdrawal of claims 11-16 from consideration, and has maintained one rejection of the claims. Applicants respectfully offer the following remarks to overcome or traverse each of these elements of the Advisory Action.

III. The Double-Patenting Rejection

In the Advisory Action at page 3, the Examiner has maintained the rejection of claims 1-9, 17-28 and 33-41 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-33 of commonly owned U.S. Patent No. 6,576,235. Applicants respectfully traverse this rejection, and reiterate and incorporate herein the remarks concerning this rejection that were provided in Applicants' Amendment

¹ Applicants note that the Advisory Action of November 17, 2003, states that claims 1-9, 17-28 and 33-41 are pending. *See, e.g.*, Form PTOL-303 and Advisory Action at page 2. However, claims 33-36, 38 and 39 were cancelled in Applicants' Amendment and Reply filed in the present matter on September 9, 2003 (*see* page 9, section II, of that filing). Hence, claims 1-9, 17-28, 37, 40 and 41 are currently pending.

and Reply filed in the present matter on September 9, 2003.

However, solely to expedite prosecution of the present application and allowance of all pending claims, and not in acquiescence to this rejection, Applicants have filed herewith a Terminal Disclaimer Under 37 C.F.R. § 1.321(c). Hence, this rejection has been overcome; reconsideration and withdrawal of the rejection, and allowance of all pending claims, are respectfully requested.

IV. The Withdrawal from Consideration of Claims 11-16

In the Advisory Action at page 2, the Examiner has again indicated that claims 11-16 are withdrawn from consideration. In reiterating this withdrawal of claims 11-16, the Examiner states that claims 11-16 are “drawn to a nonelected species, there being no allowable generic or linking claim.” Advisory Action of November 17, 2003, at page 2. Applicants respectfully disagree with these contentions.

Applicants respectfully assert that generic claim 1 and dependent claim 2 (encompassing the elected species, mammalian uricase) are allowable, in view of the remarks contained above and the filing of the Terminal Disclaimer. Claims 11-16 are all drawn to specific non-mammalian uricases, and depend directly or ultimately from generic claim 1. Thus, claim 1 represents an allowable generic claim that links claims 11-16 and the elected species recited in claim 2. During a telephone conference on December 4, 2003, Examiner Pak informed Applicants’ undersigned representative that upon allowance of generic claim 1 (*i.e.*, upon filing of the Terminal Disclaimer which removes all remaining rejections to the

present claims), claims 11-16 would be rejoined and considered in accordance with 37 C.F.R. § 1.141(a) and 1.146, and MPEP § 809.02(c)(B). Accordingly, it is respectfully requested that claims 11-16 be rejoined with the remaining claims that have now been placed into condition for allowance, and that claims 11-16 also be allowed.

V. Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all of the outstanding objections and rejections, rejoin claims 11-16, and allow all pending claims.

It is respectfully believed that the present application is in condition for immediate allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

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